

REMARKS

Applicant wishes to thank the Examiner for reviewing the present application and the helpful comments.

Amendments to the Specification

The Examiner objected to the title for being not sufficiently descriptive. The specification is amended to provide a new title. It is submitted that the new title is clearly indicative of the invention to which the claims are directed.

The Examiner also objected to the specification for failing to provide proper antecedent basis for the claimed subject matter and requested its correction. Paragraph 25 is amended to provide the proper antecedent basis to claims 52-56.

Additionally, paragraph 25 is amended to further clarify that a software system may be executing on any suitable hardware, as is generally understood by those skilled in the art.

No new subject matter is introduced by way of these amendments.

Amendments to the Claims

Independent claims 14, 24 and 37 are amended to provide further details on negotiating a category acceptable to the receiver subsystem. In particular, these claims are amended to clarify that the negotiation of category is initiated by the sender subsystem, the category being negotiated is selected by the sender subsystem and the sender subsystem categorizes the message to be sent only upon receiving an indication from the receiver subsystem during the negotiation that the selected category is acceptable to the receiver subsystem. They are further amended to recite the generation of a categorized message as a result of the negotiation. Independent claims 47 and 52 are amended to clarify that selecting and initiating negotiation of a category are carried out by the sender system and that acceptance of the category is provided by the receiver system.

Their respective dependent claims 15-23, 25, 29, 31-34, 38-46 and 53 are amended accordingly in view of amendments to the independent claims and for additional clarity.

Support can be found in the description (see, for example, paragraphs 28, 33, 34, 36, 42 and 43). No new subject matter is introduced.

Claim Rejections under 35 USC §101

The Examiner rejected claims 14-36 under 35 USC §101 on the ground that these claims were directed to non-statutory subject matter.

Independent claims 14 and 24 have been amended to recite a sender subsystem and a receiver subsystem that communicate with each other to negotiate a category selected by the sender subsystem and acceptable to the receiver in order to categorize a message.

The Examiner noted that the description indicates that an agent may be a software system. The description also indicates that an agent may be a combination of software and hardware systems. The description is also amended to further clarify that where reference is made to a software system, the software system is understood to be executing on any suitable hardware system and/or is stored in any computer readable medium, as is generally understood by a person of ordinary skill in the art. Further, in the description, it is described that the sender agent and the receiver agent interact over a communication link 406, i.e., the disclosure describes at least implicitly the execution of the software systems on suitable computation devices linked by communication links, such as telecommunication cables. Thus, it is respectfully submitted that the systems as claimed in claims 14-36 are not software *per se*, but rather, a novel and inventive system controlled by software systems executing on suitable hardware which are in turn connected through communication links.

In addition, claims 14 and 24 have also been amended to recite the generation of a categorized message, transformed from an uncategorized electronic message, which

provides a useful, concrete and tangible result. For this additional reason, it is respectfully submitted that claims 14-36, as amended, are directed to statutory subject matter.

The Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 14-36 on this ground.

Claim Rejections under 35 USC §102

The Examiner rejected claims 14-17, 20, 23, 37-42 and 47-56 under 35 USC §102 as being anticipated by Schiavone et al. (U.S. Patent Application Publication No. 2002/0120600). The Examiner was of the view that Schiavone disclosed all limitations of each of these claims.

Claims 14, 37, 47 and 52 are independent claims. Claim 15-17, 20, 23 depend from claim 14; claims 38-42 depend from claim 37; claims 48-51 depend from claim 47; and claims 53-56 depend from claim 52.

As noted above, each of claims 14, 37, 47 and 52 has been amended to clarify that the negotiation of category is initiated by the sender subsystem, the category being negotiated is selected by the sender subsystem and the sender subsystem categorizes the message to be sent only upon receiving an indication from the receiver subsystem during negotiation that the selected category is acceptable to the receiver subsystem.

Schiavone describes a method and system for negotiating an electronic mail transaction. The system is a rule-based system, and "the rule includes a conditional instruction conditioned upon a result of a logic or other function of recipient profile data". (Abstract, Schiavone; see also Fig. 1 and the related description in Schiavone). The sender modifies a message prior to transmission according to rules or conditions already received from the receiver, but does not otherwise interact with the receiver. For example, in paragraph [0054], Schiavone teaches that "the method starts with the storing of recipient preference data ... [which] includes information that the recipient agrees to share with third parties." The sender stores the recipient preference data in

its preference data store 160. Prior to sending a message, the sender references the data stored in the preference data store 160 and modifies the message accordingly to assign a value to a recipient dependent variable based on the stored recipient preference data (see, e.g., paragraphs [0055], [0058] and [0059] in Schiavone). The processing of a message to be transmitted is entirely on the sender's side. There is no active negotiation initiated by the sender system with the recipient system when sending a message.

As Schiavone at least does not teach a system and method that includes, when sending a message, negotiation of a category initiated by the sender subsystem and categorizing a message with the negotiated category only upon receiving an indication from the receiver subsystem that the negotiated category is acceptable to the receiver system, it is respectfully submitted that claims 14, 37, 47 and 52, as amended, are not anticipated by Schiavone.

Claims 15-17, 20, 23, 38-42 and 48-56 each depend directly or indirectly from one of claims 14, 37, 47 and 52. They therefore incorporate by reference all limitations of the corresponding independent claims. Accordingly, it is respectfully submitted that these claims are not anticipated by Schiavone at least for the same reason as discussed above in connection with their respective independent claims 14, 37, 47 and 52.

Therefore, the Applicant respectfully requests the reconsideration and withdrawal of the rejections of claims 14-17, 20, 23, 37-42 and 47-56 under 35 USC §102 relying on Schiavone.

Claim Rejections under 35 USC §103(a)

(a) Claims 18, 19 and 44-46

The Examiner rejected claims 18, 19 and 44-46 under 35 USC §103(a) as being obvious over Schiavone, in view of U.S. Patent Application Publication No. 2002/01204748 ("Koenig").

Koenig describes a method and system for selective delivery and forwarding of electronic mail. Selection criteria are pre-established by recipient for determining how an incoming e-mail message will be delivered and routed (Abstract, Koenig). However, Koenig does not teach active negotiation of a category by a sender subsystem. As discussed above in connection with claims 14 and 37, Schiavone also does not disclose active negotiation as recited. Therefore, even if Schiavone and Koenig could be combined, as asserted by the Examiner, the combined teaching of Schiavone and Koenig still would not disclose each and every limitation of claims 14 and 37, as discussed above. As claims 18 and 19 depend from claim 14 and claims 44-46 depend from claim 37, a combination of Schiavone and Koenig also would not disclose each and every limitation of any one of claims 18, 19 and 44-46.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP §2143.03. As the combined teaching of Schiavone and Koenig does not teach all the claim limitations of any one of claims 18, 19 and 44-46, it is respectfully submitted that Schiavone and Koenig do not render any one of claims 18, 19 and 44-46 obvious. The withdrawal of the rejection of claims 18, 19 and 44-46 is respectfully requested.

(b) Claims 21, 22, 24-26, 29-36 and 43

The Examiner rejected claims 21, 22, 24-26, 29-36 and 43 under 35 USC §103(a) as being unpatentable over Schiavone.

(i) Claims 21, 22 and 43

Claims 21, 22 depend from claim 14 and claim 43 depend from claim 37. As discussed above in connection with claims 14 and 37, Schiavone does not disclose each and every limitation of either of claims 14 and 37. There is also no evidence that any common general knowledge would provide the missing teaching. As claims 21, 22 and 43 depend from one of claims 14 and 37, they incorporate by reference all claim limitations of one of claims 14 and 37. It is respectfully submitted that claims 21, 22 and

43 are allowable over Schiavone at least for the reasons discussed above in connection with claims 14 and 37.

(ii) Claims 24-26 and 29-36

Claim 24 is an independent claim. Claims 25-26 and 29-36 depend from claim 24. Claim 24, as amended, recites a negotiation module that initiates a negotiation on behalf of sender to identify a category for a message to be sent and categorizes the message with the negotiated category only upon receiving an indication from the receiver subsystem that the category is acceptable. This is not disclosed in Schiavone as discussed above in connection with claims 14, 37 and 47. There is also no evidence that any common general knowledge would provide the teaching of such a negotiation module as recited in claim 24. Therefore, Schiavone, or in combination with any common general knowledge, would not render claim 24 obvious.

Accordingly, it is respectfully submitted that claim 24 is allowable over Schiavone. As claims 25, 26 and 29-36 depend from claim 24 and therefore incorporate by reference all claim limitations of claim 24, for at least the same reason, it is respectfully submitted that these dependent claims of claim 24, namely claims 25, 26 and 29-36, are also allowable over Schiavone.

(c) Claims 27 and 28

The Examiner rejected claims 27 and 28 under 35 USC §103(a) over Schiavone, in further view of U.S. Patent Application Publication No. 2004/0111478 ("Gross").

Claims 27 and 28 depend from claim 24. As discussed above in connection with claim 24, Schiavone does not disclose each and every limitation of claim 24, in particular, a negotiation module as recited in claim 24.

Gross also does not provide the teaching of a negotiation module as recited in claim 24. Gross is concerned with a system that enables message processing in accordance with pre-established criteria received from recipients. See, for example,

paragraphs [0042], [0045] and [0051]-[0057] in Gross. The Examiner cited Gross as an example that discloses selecting a category from a receiver listing and mapping it to a sender listing. Gross, however, does not teach a negotiation module that is configured to carry out an active negotiation as recited in claim 24.

As neither Schiavone nor Gross discloses a negotiation module that is configured to carry out an active negotiation as recited in claim 24, it is respectfully submitted that a combination of Schiavone and Gross also would not teach all the claim limitations of claim 24. Accordingly, a combination of Schiavone and Gross also would not teach all the claim limitations of either of claims 27 and 28, which depend from claim 24. Therefore, it is respectfully submitted that claims 27 and 28 are both allowable over Schiavone and Gross and the withdrawal of rejection of claims 27 and 28 is respectfully requested.

In view of the above discussion, the Applicant respectfully requests the reconsideration and withdrawal of the rejections of claims 18, 19, 21, 22, 24-36 and 43-46, under 35 USC §103(a).

Conclusion

In view of the foregoing, the Applicant respectfully submits that claims 14 to 56, as amended, are all novel, non-obvious and directed to statutory subject matter and are all allowable over the references cited. The Applicant respectfully requests the reconsideration of the rejections of these claims and allowance of the present application.

The Examiner is invited to contact the undersigned by telephone to discuss this case further, if necessary, at (416) 863-5839.

Respectfully submitted,



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